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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHANKONG, DOHM

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/767,474	Applicant(s) OLLIS ET AL.	
	Examiner DOHM CHANKONG	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/1/2004, 8/8/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- 1> Claims 1-20 are presented for examination.
- 2> This is a non-final rejection.

Information Disclosure Statement

- 3> The information disclosure statements (IDS) submitted on 11.1.2004 and 8.8.2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 4> Claims 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims claim a computer-readable medium. In general, such mediums would be interpreted as an appropriate manufacture (a computer-readable medium is neither a process, a machine, or a composition of matter) within the meaning of §101. However, claims that are written broadly enough to include communication media such as signals and carrier waves fail to fall within a statutory category because signals and waves are not viewed as a manufacturer within the meaning of §101.

Here, Applicant's specification distinguishes between "computer storage media" and "communication media" but discloses that a "computer readable medium" is intended to cover both terms [pg. 3 «lines 28-29»]. Applicant discloses examples of "communication media" as including data in a modulated data signal such as a carrier wave and wireless media such as acoustic and RF. These examples of communication media do not fall within a statutory category because they are not structurally and functionally interconnected to the data in such a manner as to enable the data (within the communication media) to act as a computer component and realize its functionality.

Because they encompass non-statutory matter, the claims are rejected for being directed towards non-statutory subject matter. Applicant is advised to amend the claim to refer only to computer storage media since the intrinsic evidence provided in Applicant's specification (examples of storage media including memory and portable storage devices) would have led one of ordinary skill in the art to interpret "computer storage media" as a manufacture within the meaning of §101.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5> Claims 1, 2, 11, 14, and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- a. Claims 1 and 16 are rejected for lacking proper antecedent basis: “the user’s personal contacts;”
- b. Claims 2 and 11 are rejected for lacking proper antecedent basis: “the user’s emails;”
- c. Claim 14 is rejected for lacking proper antecedent basis: “the user’s sent emails;”
- d. Claims 16-20 are rejected for being unclear. The claims are directed to a computer-readable medium that comprise method steps. It is unclear how a medium could comprise “beginning a synchronization session” as disclosed in claim 16.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6> Claims 1, 2, 6-11, 15, 16, 19, and 20 are rejected under 35 U.S.C. §102(b) as being anticipated by Huang et al, U.S. Patent No. 5,966,714 [“Huang”].

7> As to claim 1, Huang discloses a method for populating a list of GAL contacts on a device, comprising:

automatically selecting global address list (GAL) contacts for a user that are unique from the user's personal contacts [column 4 «line 50» to column 5 «line 4» : receiving only a subset of the larger address book | column 6 «lines 1-14» | Figure 3e «item 347» : selecting contacts based on scanning email addresses from a user's Email folders and archives and determining whether the address is already in the user's personal address book (PAB)];

preparing the GAL contacts [column 7 «lines 26-32» | Figure 3e «item 350» : preparing the information from the master address book | column 9 «lines 63-66»]; and

providing the GAL contacts to a device [Figure 3e «item 355» | column 9 «lines 63-66»].

8> As to claim 2, Huang discloses automatically selecting the GAL contacts further comprises obtaining the GAL contacts from the user's emails [column 5 «line 67» to column 6 «line 7»].

9> As to claim 6, Huang discloses providing the GAL contacts to the device further comprising providing updates to the device in order to update a GAL contact store on the device [column 4 «line 62» to column 5 «line 1» | column 6 «lines 60-64»].

10> As to claim 7, Huang discloses limiting the number of GAL contacts provided to the device [column 6 «lines 37-40» : downloaded contacts are limited to the "highest ranked entry"].

11> As to claim 8, Huang discloses maintaining a user snapshot list outside of the device that is related to the GAL contacts for the user [Figure 1c «item 128» | column 6 «lines 37-40» : snapshot of the highest ranked addresses stored at the host device (outside of the user's mobile device)].

12> As to claim 9, Huang discloses displaying the GAL contacts along with the user's personal contacts [Figure 1d].

13> As to claim 10, Huang discloses a system for populating a list of GAL contacts on a device, comprising:

a device including a communication connection, a data store, a display, and a processor that is configured to perform the following actions [Figure 1a «item 106» | Figure 1c «item 106» | column 5 «lines 36-37»], including:

connecting to a network using the communications connection to perform a synchronization [column 5 «lines 17-42»];

receiving an update list from the network containing information to update global address list (GAL) contacts that are unique from a user's personal contacts [column 2 «lines 27-31» : a change list | column 4 «lines 5-10» : generating a subset of a large address book];

updating the GAL contacts [column 4 «line 62» to column 5 «line 1» | column 6 «lines 60-64»];

storing the updated GAL contacts in the data store [column 4 «lines 50-54» :
memory within the client device]; and

displaying the GAL contacts on the display [Figure 1d];

a server including a communications connection, a data store, and a processor that is
configured to perform the following actions [Figure 1c «items 127, 102»], including:

obtaining the GAL contacts for the user [column 6 «lines 8-12»];

preparing an update list based on the GAL contacts in the data store on the
device and the obtained GAL contacts [column 7 «lines 26-32» | Figure 3e «item 350» :
preparing the information from the master address book | column 9 «lines 63-66»];
and

providing the GAL contacts to a device over the network [Figure 3e «item 355»
| column 9 «lines 63-66»].

14> Claims 11 and 15 are directed to a system that implements the steps of the method of
claims 2 and 9, respectively. Therefore claims 11 and 15 are rejected for at least the same
reasons set forth for claims 2 and 9.

15> As to claim 16, Huang discloses a computer-readable medium for populating a list of
GAL contacts on a device, comprising:

beginning a synchronization session [column 4 «lines 5-18»];

automatically selecting global address list (GAL) contacts for a user that are unique

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from the user's personal contacts from the user's emails [column 4 «line 50» to column 5 «line 4» : receiving only a subset of the larger address book | column 6 «lines 1-14» | Figure 3e «item 347» : selecting contacts based on scanning email addresses from a user's Email folders and archives and determining whether the address is already in the user's personal address book (PAB)]; and

providing the GAL contacts to a device [Figure 3e «item 355» | column 9 «lines 63-66»].

16> Claims 19 and 20 are directed to a computer-readable medium that implements the steps of the method of claims 6 and 8, respectively. Therefore, claims 19 and 20 are rejected for at least the same reasons set forth for claims 6 and 8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17> Claims 3, 12, 14, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Huang, in view of Kraenzel et al, U.S. Patent Publication No. 2005|0198144 [“Kraenzel”].

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18> As to claims, 3, 12, 14, and 17, Huang does disclose obtaining a primary addressee from sent emails from the user [column 5 «line 67» to column 6 «line 7» | column 7 «lines 62-65» | column 9 «lines 44-67»], but does not expressly disclose scanning a predetermined number of sent emails from the user. However, the feature of specifying a number of sent emails to be retrieved and scanned was well known in the art at the time of Applicant's invention as evinced by Kraenzel.

Kraenzel is directed towards a system for managing message addressed by extracting the information from emails [abstract]. Kraenzel discloses that a user can specify the number of emails to search to extract the addressee information [Figure 3 : specifying number of messages if more than a certain number | 0060-0062]. It would have been obvious to one of ordinary skill in the art to have adapted Huang's system to include Kraenzel's user selectable filters. One would have been motivated to adapt Huang because the filters increase the amount of control that a user has over the number of messages to be scanned.

19> Claims 4, 5, 13, and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Huang, in view of Lake, U.S. Patent No. 7,200,638.

20> As to claims 4, 5, 13, and 18, Huang does not expressly disclose obtaining the GAL contacts from meeting requests. However, the feature of extracting contact information from meeting requests was well known in the art at the time of Applicant's invention as evinced by Lake.

Lake is directed towards a system for automatically populating a contact list

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[abstract]. Lake teaches that one of the ways to accomplish this task is to extract the contacts from meeting information found in a user's calendar [Figure 3 | column 2 «lines 6-11»]. It would have been obvious to one of ordinary skill in the art to have adapted Huang's system to include Lake's automatic population functionality. Lake teaches that such a feature more efficiently manages a user's contact list [column 1 «lines 51-62»].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following cited art are all directed towards the management of contact lists.

Kucala, U.S. Patent No. 6.243.705 - Figure 2;

Chen et al, U.S. Patent Publication No. 2002|0049751 - abstract;

Gropper, U.S. Patent Publication No. 2002|0049610 - abstract;

Kobashikawa et al, U.S. Patent Publication No. 2004|0186848;

Kucharewski et al, U.S. Patent Publication No. 2004|0199581 - abstract;

Likwornik, U.S. Patent Publication No. 2004|026614;

Osborn, U.S. Patent No. 6.760.728 - Figure 7;

Burkey et al, U.S. Patent No. 6.845-370 - abstract;

Nishio et al, U.S. Patent No. 7.092994 - column 2 «lines 1-10»;

Caughey, U.S. Patent No. 7.334.020 - Figure 5.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2152
(temporary partial signatory authority)